

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re	) ) ) ) )	Decision on Petition for Review Under 37 CFR § 10.2(c)
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MEMORANDUM AND ORDER

(Petitioner) seeks review of the decision of the Director of the Office of Enrollment and Discipline (OED) dated March 12, 1996, denying Petitioner's request for a higher score on the morning section of the Examination to Practice in Patent Cases Before the U.S. Patent and Trademark Office held on November 2, 1994 (Examination). The petition is denied.

Background

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both morning and afternoon sections of the Examination. Petitioner scored a 64 on the morning section of the Examination and passed the afternoon section of the Examination.

On or about February 17, 1995, petitioner mailed a Request for Regrading of questions 14, 24, 27 and 32 from the morning section of the Examination. On March 13, 1995, Petitioner mailed an amended Request for Regrading for questions 2 and 19 from the morning section of the Examination.

A decision from OED was mailed to petitioner on March 17, 1995. This decision did not add any points to Petitioner's score. On April 6, 1995, a supplemental decision was mailed by OED, in response to Petitioner's amended Request for Regrading. The supplemental decision also added no points to Petitioner's score.

By petition to the Director dated April 9, 1995, Petitioner requested reconsideration of the March 17 and April 6 decisions. In a decision mailed May 12, 1995, the Director determined that no additional points should be awarded. A second petition for reconsideration was filed on June 12, 1995. On March 12, 1996, the Director issued her Second Decision, confirming that petitioner was entitled to no additional points.

By petition mailed April 11, 1996, Petitioner requests that the Commissioner reverse the Director's denial of credit for questions 2, 14, 19, 24, 27 and 32. For questions 2, 14, 19 and 32, where petitioner asserts that the PTO model answer is incorrect, Petitioner seeks double credit to "put Examinee on an equal footing with these other applicants." (Pet. at 39).

#### Opinion

Pursuant to 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions to the morning section state: "No points will be awarded for incorrect answers or unanswered questions." Therefore, the burden is upon the Petitioner to show that his

chosen answer is the most correct answer. Petitioner has failed to meet this burden.

Furthermore, petitioner's arguments are replete with assumptions that are not supported by the facts presented in the questions. The directions to the morning section also state:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent agent. The most correct answer is the policy, practice and procedure which must, shall or should be followed in accordance with U.S. patent statutes, the PTO rules of practice or procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette.

Petitioner has presented numerous arguments attacking the validity of the questions and the Director's Second Decision. All of petitioner's arguments have been considered, but lack merit. For the following reasons, no points will be added to Petitioner's score for the morning section of the Examination.

## QUESTION 2

Question 2 read as follows:

2. A petition and fee for an extension of time cannot be granted for filing \_\_\_\_\_.
- (A) a response to a Quayle action  
...  
(D) a reply brief  
...

In the model answer, choice (D) is identified as the correct answer on the basis of 37 C.F.R. § 1.136(a)(1)(ii). This

provision explicitly provides that reply briefs in ex parte appeals are not subject to the automatic petition and fee extension of time procedures of Rule 1.136(a).

Petitioner selected choice (A). This choice is incorrect. Rule 136(a) provides for "petition and fee" requests for extension of time where the PTO has set a shortened statutory period for responding to the action. MPEP 710.02(b) provides that a shortened statutory period of time is set for response to *Ex Parte Quayle* Office actions. Because Quayle actions are subject to a shortened statutory period, the petition and fee extension of time procedures of 37 C.F.R. § 1.136(a) are applicable to them.

Petitioner argues that the need to consult a source (the MPEP) that is "one step farther removed" from the rules makes choice (A) the best answer. This argument lacks merit. The Examination covers all aspects of practice before the PTO. The fact that an answer may be located in the MPEP, rather than the rules, does not make the MPEP answer any more or less correct. Choice (A) is incorrect for the reasons set forth above.

In the alternative, Petitioner asserts that choice (D) is also incorrect and therefore that question 2, having no correct answer, should be deleted. Petitioner advances several arguments to support his position. None of these arguments have merit.

Petitioner argues that the question was improperly reconstructed by the Director to remove ambiguities in the model answer. This argument is unpersuasive because the question is not ambiguous. The "petition and fee" extension of time practice pursuant to 37 C.F.R. § 1.136(a) is well understood by practitioners. For certain responses, it provides an extension of time without the need to show good cause. Petitioner's parsing of the question in an attempt to raise an ambiguity is not persuasive of any error in the question. Accordingly, the question is not improperly ambiguous and the Director did not improperly "reconstruct" the question.

Petitioner also argues that the term "reply brief" has several meanings before the PTO. Petitioner asserts that the PTO must show that there are no other documents denominated as reply briefs to prove that the model answer is correct. This reasoning is also flawed. The burden is on petitioner, not the PTO, to show that the question is incorrect. Petitioner has failed to establish that no answer to the question is correct and the PTO need not prove the negative.

Petitioner's argument that the interference rules permit "reply briefs," and thus that a petition for an extension of time filed for a reply brief can be granted, is unpersuasive. The interference rules specifically provide that the "petition and fee" procedures of 37 C.F.R. § 1.136 do not apply to papers filed in interferences. 37 C.F.R. § 1.645(c). Accordingly, whether or

not there is a document in an interference that can be properly called a "reply brief," the petition and fee procedures for extension of time do not apply and choice (D) remains correct.

Petitioner next argues that the question, by its terms, does not specify practice before the PTO. This argument also lacks merit. The Examination only tests practice and procedure before the PTO.

Finally, petitioner references his earlier argument that 37 C.F.R. § 1.136(b) allows for an extension of time for reply brief. The directions instruct examinees not to assume additional facts not presented in the question. As correctly noted by the Director, Rule 1.136(b) requires a showing of good cause. Because the facts do not indicate that a showing of good cause has been made, Rule 1.136(b) is inapplicable.

Petitioner's request for credit on question 2 is denied.

#### QUESTION 14

Question 14 read as follows:

14. Which one of the following *is not required* to obtain an international filing date for an application filed under the Patent Cooperation Treaty (PCT)?

- . . . . .  
(B) That the application be in a prescribed language.  
. . . . .  
(D) The name of the inventor.  
. . . . .

In the model answer, choice (D) was identified as the correct answer on the basis of Article 11 of the PCT.

Petitioner selected choice (B). However, Petitioner has failed to show that his proposed answer is correct. Article 11(1) of the PCT sets forth the requirements for a PCT application to receive an international filing date. These requirements include:

- (ii) the international application is in the prescribed language, [Choice (B)]
- (iii) the international application contains at least the following elements:
  - (a) an indication that it is intended as an international application, [choice (E)]
  - (b) the designation of at least one Contracting State, [choice (C)]
  - (c) the name of the applicant, as prescribed,  
.
  - (e) a part which on the face of it appears to be a claim or claims. [choice (A)].

As is readily apparent from the above excerpt of the PCT, the requirements set forth in choices (A), (B), (C) and (E) are all required by the PCT to obtain an international filing date. Only choice (D), that the inventor be identified, is not required by the PCT to obtain an international filing date. The PCT only requires the identification of the applicant, who under PCT rules need not be the inventor. MPEP 1805, PCT Rule 18. Because the PCT does not require identification of the inventor to obtain an international filing date, choice (D) is the correct answer.

Petitioner's lengthy arguments about the question being "out of context" are non-persuasive of error. The question tests knowledge of the requirements for obtaining an international filing date under the PCT. Accordingly, the proper reference

point for any answer to this question is Article 11 of the PCT, the section that sets forth the requirements for obtaining an international filing date.

Petitioner has failed to establish that choice (B) is the correct answer. Petitioner's lengthy semantic argument that the term "a prescribed language" requires a single prescribed language has been considered but lacks merit. Choice (B) does not imply that there is a single prescribed language, but rather specifies that the language used must be one of those that is prescribed. The PCT provides that the application must be in "the prescribed language" but recognizes that more than one "prescribed language" is possible. That more than one language may be the "prescribed language" does not render the question improper or otherwise erroneous and does not make choice (B) the correct answer.

Petitioner's request for credit on question 14 is denied.

#### **QUESTION 19**

Question 19 read as follows:

19. You are the only agent of record in a patent application filed on behalf of your client Early. The application is currently under rejection. A response is due on November 10, 1994. You are on vacation and not expected to return to your office until November 14, 1994. Today, November 2, 1994, Early calls your secretary and wants the response to the rejection filed today in order to avoid paying an extension of time fee. Your partner, John, who is also a registered patent agent, is familiar with the application and tells Early that he will prepare and file the response



today. Can John properly prepare and file the response without having a power of attorney from Early?

(A) No, because John is not an attorney of record.

(D) Yes, because John is a registered patent agent and his signature on the response constitutes authorization to represent Early.

. . . . .

In the model answer, choice (D) was identified as the best answer, citing 37 C.F.R. § 1.34(a).

Petitioner asserts that choice (A) is the most correct answer. Choice (A) answers the question "no" and provides a reason, that "John is not an attorney of record." Both the answer and the reasoning are incorrect. Rule 34(a) provides that a practitioner need not be listed on a power of attorney to file a paper in the application. The practitioner's signature constitutes a representation that he is authorized to file the relevant paper. Accordingly, John is not required to be an attorney of record to sign the response and petitioner's suggested choice (A) is incorrect.

Choice (D) is the best answer to the question. It is the only answer that recognizes that the signature of the practitioner constitutes a representation that he has authority to file the relevant document, irrespective of the power of attorney. The question provides that John has spoken with Early, who has instructed him to file the amendment. Accordingly, John may properly file the response and his signature constitutes a representation of his authority to file the paper.

Petitioner's request for credit on question 19 is denied.

#### QUESTION 24

Question 24 read as follows:

24. You filed a patent application in the PTO today, November 2, 1994. The application as filed consisted of a specification containing a description in accordance with 37 CFR 1.71, necessary drawings, ten claims and the name of the actual inventor. The inventor is on vacation and is unavailable to execute the oath. He is expected to return on November 16, 1994 to execute the oath so that it can be filed in the PTO on November 17, 1994. After filing the application, you realize that you failed to include two claims directed to an embodiment of the invention which was not claimed, and which is neither illustrated and shown in the drawings nor described in the specification. You have prepared an amendment to add these new claims to the application, and to add drawing figures and a description of the embodiment to the specification. Which of the following procedures, if any, will result in the new claims being entitled to a filing date of November 2, 1994, without the claims being new matter?

- (B) File the amendment today and then, on November 17, 1994, file an original oath which properly references the amendment.
- (E) None of the above procedures are acceptable because without an original oath, the application is not entitled to a filing date of November 2, 1994.

In the model answer, choice (B) is identified as the correct answer, citing MPEP 601.01.

Petitioner asserts that choice (E) is the correct answer. Choice (E) is incorrect because 37 C.F.R. § 1.53(d) provides that declaration does not have to be filed at the same time as the application in order for the application to receive a filing

date. Rule 53(d) provides appropriate procedures that allow for the later filing of a signed declaration while maintaining the earlier filing date.

Petitioner asserts that for (B) to be correct, it is necessary to make an assumption "that the discovery was made on November 2, 1994." (Petition at 26-27).<sup>1</sup> However, petitioner overlooks the first sentence of question 24 which states that today is, in fact, November 2, 1994. Accordingly, no assumption is required to arrive at the correct answer because the question clearly states that today, the date that "you" discover the error, is November 2, 1994, the same day that the application was filed. MPEP 601.01 provides that an amendment filed on the same date as the application that is properly referenced in the signed oath or declaration shall not be new matter. For this reason, choice (B) is correct.

Petitioner's request for credit on question 24 is denied.

#### **QUESTION 27**

The fact pattern supporting question 27 is quite extensive and is attached hereto as Appendix A. Question 27 read as follows:

27. In December of 1993, Mary decided that she wanted to file a patent application claiming the lens she

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<sup>1</sup> The section of Petition entitled "a succinct response" makes reference to choice (A) as being the correct answer identified by OED. This appears to be a typographical error and will be treated as such.

invented. Is Mary entitled to a U.S. patent for her lens invention?

(A) No, because the sales brochure is a statutory bar.

(E) Yes, because the sales activity did not occur in the United States.

The model answer identified choice (A) as correct, citing 35 U.S.C. § 102(b). Mary, by distributing the sales brochure to potential manufacturers of lenses, has created a statutory printed publication bar under section 102(b).

Petitioner argues that choice (E) is correct. Petitioner argues that the brochure was not publicly distributed and that the secrecy of the brochure depends on the law and custom of English lens manufacturers. Petitioner's assertions are incorrect.

Contrary to petitioner's argument, *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986) supports the finding of a statutory bar. *Hall* provides that disclosure of the information to "the public interested in the art" is the critical issue. Here, the "interested public" are the manufacturers who received the information. Accordingly, while the information might not be available to some broad segment of the public at large, as apparently urged by petitioner, this does not preclude the imposition of a statutory bar. Indeed, in addition to *Fox*, cited in the Director's decision, numerous cases have found distribution of reports or sales brochure to a limited number of

entities without restriction on use constitutes a publication bar. *E.g.*, *Torin Corp. v. Philips Indus.*, 625 F. Supp. 1077, 1089-90, 228 USPQ 465, 472-73 (S.D. Ohio 1985) (dissemination of a sales brochure to an English company and to English sales representatives and through them to plaintiff's customers constituted a publication bar under 102(b)); *Garrett Corp. v. United States*, 422 F.2d 874, 878 164 USPQ 521, 524 (Ct.Cl.) cert. denied, 400 U.S. 951 (1970); *Friction Division Prods. Inc. v. E.I. DuPont de Nemours & Co.*, 658 F. Supp. 998, 1008, 3 USPQ2d 1775, 1781 (D. Del. 1987).

Because Mary's distribution of the documents to the manufacturers constituted a publication bar, choice (E) is incorrect. Petitioner has failed to show that his answer is correct. Accordingly, petitioner's request for credit on question 29 is denied.

#### QUESTION 32

Question 32 read as follows:

32. You are representing a client in an interference proceeding. During the proceeding, you become aware of information concerning the conduct of opposing counsel in the interference which you believe would be a violation of the PTO Code of Professional Responsibility. Do you have a duty to disclose this information to the PTO?

.. .  
(C) Yes, if the information is not privileged.

.. .  
(E) Yes, but only if the opposing counsel refuses to inform the Office of Enrollment and Discipline concerning the alleged misconduct.

In the model answer, the correct answer was identified as choice (C) citing 37 C.F.R. § 10.23(c)(16) and 10.24(b).

Petitioner, in his request for regrade, correctly pointed out that the rule cited to support choice (C) did not, in fact, support choice (C). However, 37 C.F.R. § 10.24(a) supports choice (C) as the correct answer.

Petitioner asserts that choice (E) is correct. Rule 10.24(a) provides that a practitioner having "unprivileged knowledge of a violation of a Disciplinary Rule shall report such knowledge to the Director." Choice (C) is the only answer which recognizes a practitioner's duty to provide the information and incorporates the one significant limitation on that duty, that the information come from an unprivileged source.

Petitioner asserts choice (E) is correct. Choice (E) is incorrect because it requires an assumption not provided in the question or in choice (E), that the information you possess is unprivileged. The requirement that the information is unprivileged is a prerequisite both for reporting it to OED and for any discussion with opposing counsel. Because choice (E) does not provide that the knowledge is unprivileged, it is not correct.

Petitioner argues that there is a difference between "belief" and "knowledge" and that the failure of the question to specifically use the term "knowledge" renders choice (C)

incorrect. Close examination of the question, however, reveals that this argument lacks merit.

The question makes clear that the practitioner in the question has knowledge of his opponent's acts by stating "you become aware of information concerning the conduct of opposing counsel." Obviously, if "you" are aware of your opponents conduct, "you" have "knowledge" of the information. The "belief" that petitioner references relates to the subjective conclusion that the conduct in question rises to the level of a disciplinary violation. This is a subjective legal conclusion that the conduct, of which "you" have knowledge is a disciplinary violation. Accordingly, the knowledge of your opponents conduct -- clearly set forth in the question and requiring no assumptions -- mandates disclosure to OED, if the information is not privileged. Accordingly, choice (C) is the most correct answer.

Petitioner also raises, by implication, earlier arguments made to the Director about the distinction between a violation of a disciplinary rule and violation of the "PTO code." This distinction is without merit. The PTO code is composed of canons and disciplinary rules. 37 C.F.R. § 10.20. The canons are statements of axiomatic norms to be attained by practitioners, that is, they are aspirational. § 10.20(a). Conversely, disciplinary rules are "mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action." § 10.20(b).

Failure to attain the canons cannot be a violation of the PTO code because the canons are not mandatory in nature and do not state a minimum level of conduct to be followed. The only manner by which the PTO code can be violated is by violation of a disciplinary rule. Accordingly, there is no difference between a violation of a disciplinary rule and a violation of the PTO code.

Petitioner's request for credit on question 32 is denied.

#### **DOUBLE CREDIT**

Petitioner requests double credit for questions 2, 14, 19 and 32 on the basis that the original answers were incorrect and that double credit is "necessary" to put him on an equal footing with other applicants. Because petitioner has not shown that his answers are the most correct and because the model answers are indeed correct, petitioner's request for double credit is deemed to be moot.

#### **PRELIMINARY ARGUMENTS**

Petitioner makes a number of preliminary arguments, for example, relating to zealous representation, administration of the Examination and alleged *ad hominem* attacks. These comments have been fully considered, but are not deemed to be persuasive of error in the Director's decision. For the reasons set forth in detail above, the model answers provided by the Director of OED are correct under the relevant statute, rule, MPEP procedure or treaty. Petitioner's comments regarding zealous



representation or *ad hominem* attacks do not change this result. Furthermore, review of the Director's decision indicates that the petition was properly denied on the merits.

CONCLUSION


Petitioner's grade for the morning section will not be changed. The final grade for the morning section is 64 points.

ORDER

Upon consideration of the Petition to the Commissioner under 37 CFR § 10.2(c), it is

ORDERED that the petition is denied.

9/16/96  
Date

  
\_\_\_\_\_  
Lawrence J. Goffney, Jr.  
Acting Deputy Assistant Secretary of Commerce  
and Acting Deputy Commissioner of Patents  
and Trademarks

## APPENDIX A

You represent XYZ Corporation which has developed an electro-mechanical iris and lens combination which significantly improves the vision of a celestial telescope. The iris and lens combination was invented by a team of engineers: Mary Fixit, Joe Lenz and Red Eye, all of whom are employees of XYZ Corporation at the time the *combination* invention was conceived and made. On July 6, 1993, you filed a patent application in the PTO with claims to the electro-mechanical iris and lens combination naming Mary, Joe and Red as the co-inventors. All rights to the combination invention have been assigned to XYZ Corporation by the inventors. The assignments were recorded in the PTO on July 28, 1993. In later discussions with the inventors, you discover that the lens itself was invented by Mary alone on January 15, 1992, while she was self-employed and living in London, England. Although Mary never filed a patent application on the lens either in the U.S. or in England, she did have a sales brochure printed and distributed in England to prospective manufacturers, describing the lens in detail. To the best of her knowledge, none of the sales brochures were ever distributed in the United States. Her brochures resulted in one sale to a celestial telescope manufacturer located in London, England on June 30, 1992. On July 6, 1993, Mary assigned all rights to her lens invention to XYZ Corporation. On September 7, 1993, you filed on behalf Mary, Joe and Red a proper information disclosure statement in the patent application in which you disclosed the sales activity including a copy of the sales brochure. In his first Office action mailed March 31, 1994, the examiner rejected in the application all of the claims under 35 U.S.C. 103 as being obvious over the sales brochure in view of a patent to Smith which discloses an electro-mechanical iris identical to that claimed in the application, but employing a different type of lens. The sales brochure can be properly combined with the patent to Smith. The examiner asserts that it would have been within the skill of the art to substitute the lens described in the brochure for the lens disclosed in the Smith patent.